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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/605,278	09/19/2003	Stanley M. Josephson	34823-400200	2277
27717	7590	08/26/2004	EXAMINER	
SEYFARTH SHAW 55 EAST MONROE STREET SUITE 4200 CHICAGO, IL 60603-5803			PATEL, SHEFALI D	
			ART UNIT	PAPER NUMBER
			2621	

DATE MAILED: 08/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/605,278	JOSEPHSON, STANLEY M.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Shefali D Patel	2621	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 September 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>9/19/03 &amp; 10/8/03</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Objections*

1. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Claims are now represented in the form of [c1] to [c20]. These ought to change to 1 to 20 because, for example, claim [c2] refers back to “claim 1” in the body of the claim when there is no claim numbered as “1”.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-4, 6-10, 12, 14-15, and 17-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Volino (US 6,400,845).

With regard to **claim 1** Volino discloses a method of processing payment material having a side with payment information (Figure 5A and Fig. 1), comprising: providing a database having at least one electronic template having biller information specific to a biller (See, col. 5 lines 5-25); scanning the side of the payment material to create a digital image (scanner 144 scanning the document into a digital (electronic) form at col. 5 line 7); parsing the digital image

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for the payment information (data parser 118, col. 5 line 3 and line 66 to col. 6 lines 1-8); and matching the payment information with the biller information (comparator 101, col. 5 lines 26-62, col. 17 lines 29-33). Please note, Volino discloses in Fig. 5A, a copy of an invoice 500 containing biller's information and such at col. 8 line 62 to col. 9 lines 1-13.

With regard to **claim 2** Volino discloses the biller information including information to identify the biller (biller's shipping address, account number, etc. on the invoice 500, col. 8 lines 62 to col. 9 lines 1-13).

With regard to **claim 3** Volino discloses the biller information including biller identifying information selected from the group consisting essentially of a mailing address (region 501, col. 8 line 65) of the biller.

With regard to **claim 4** Volino discloses the biller information including machine-readable font (the document inherently includes machine-readable font so that the zone OCR 110 is able to transform a hard copy of the document into a digital form thru a scanner 144. See, col. 5 lines 49-57).

With regard to **claim 6** Volino discloses having a bar code at col. 17 lines 23-26.

With regard to **claim 7** Volino discloses an optical character recognizable font at col. 5 lines 49-57.

With regard to **claim 8** Volino discloses an accounts receivable conversion truncation indication (See, col. 9 lines 14-22 where the document is straighten if it was slightly crooked or skewed when in the scanning mode).

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**Claim 9** recites identical features as claim 1. Thus, arguments similar to that presented above for claim 1 is equally applicable to claim 9. Note that the payment material (a document) is received at the scanner 114 as seen in Fig. 1.

With regard to **claim 10** Volino discloses the payment materials including at least one negotiable document (i.e., an invoice 500, col. 8 lines 62-67).

With regard to **claim 12** Volino discloses the payment materials including at least one accounts payable document (i.e., invoice 500 with the customer's account information at col. 8 lines 62-67, col. 9 lines 1-13).

**Claim 14** recites identical features as claim 3. Thus, arguments similar to that presented above for claim 3 is equally applicable to claim 14.

**Claim 15** recites identical features as claim 4. Thus, arguments similar to that presented above for claim 4 is equally applicable to claim 15.

**Claim 17** recites identical features as claim 6. Thus, arguments similar to that presented above for claim 6 is equally applicable to claim 17.

**Claim 18** recites identical features as claim 7. Thus, arguments similar to that presented above for claim 7 is equally applicable to claim 18.

**Claim 19** recites identical features as claim 1. Thus, arguments similar to that presented above for claim 1 are equally applicable to claim 19. Note that Volino discloses a system in Figures 1-2.

With regard to **claim 20** Volino discloses the parsing device (element 118 in Fig. 1) is selected from optical character font recognition devices (zone OCR 110 in Fig. 1).

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***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 5, 11, 13, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Volino (US 6,400,845) in view of Brooks et al. (US 5,754,673) (hereinafter, "Brooks").

With regard to **claim 5** Volino discloses method of claim 4 as disclosed above and the arguments are not repeated herein, but are incorporated by reference. Volino does not expressly disclose the machine readable font including magnetic ink character recognition (MICR) font. Brooks discloses a document that has MICR font at col. 3 lines 26-41. Volino and Brooks are combinable because they are from the same field of endeavor, i.e., image processing for financial documents. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the teaching of Brooks with Volino. The motivation for doing so is to read machine-readable information printed on the document by the MICR reader 32 as suggested by Volino at col. 3 lines 50-52. Therefore, it would have been obvious to combine Brooks with Volino to obtain the invention as specified in claim 5.

With regard to **claim 11** Brooks discloses payment document selected from the group of bank checks, etc. at col. 6 lines 1-13.

With regard to **claim 13** Brooks discloses accounts payable document selected from the group of payment coupons and bill stubs as a prior art at col. 1 lines 31-36.

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**Claim 16** recites identical features as claim 5. Thus, arguments similar to that presented above for claim 5 is equally applicable to claim 16.


***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US 6,505,173; US 5,963,966; US 5,293,429.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shefali D Patel whose telephone number is 703-306-4182. The examiner can normally be reached on M-F 8:00am - 5:00pm (First Friday Off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leo H Boudreau can be reached on 703-305-4706. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
**DANIEL MIRIAM**  
**PRIMARY EXAMINER**  
August 19, 2004

Shefali D Patel  
Examiner  
Art Unit 2621